

Applicants: Wai C. Wong, et al.

U.S. Serial No.: 09/933,106

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REMARKS

Claims 1, 3-4, 7, 10-12, 14, 21-22, 24-25 and 27-28 were pending and claims 8 and 13 were withdrawn from consideration in the subject application. By this Amendment, applicants have explicitly canceled previously withdrawn claims 8 and 13 without disclaimer or prejudice to applicants' right to pursue the subject matter of these claims in another application. Applicants have further canceled claim 7 without disclaimer or prejudice. Applicants have amended claims 10-12. Applicants maintain that the amendments to claims 10-12 not raise any issue of new matter and note that only the dependency of each claim was revised. Accordingly, upon entry of this Amendment, claims 1, 3-4, 10-12 as amended, 14, 21-22, 24-25 and 27-28 will be pending and under examination.

Initially, applicants note that the Examiner on page 2 of the May 1, 2003 Office Action has indicated that all §112 rejections made in the previous office action and the prior art rejection over Chapleo, et al. have been obviated by applicants' response to the previous office action.

Claim Rejection: 35 U.S.C. §102 - Henry, et al.

On page 2 of the Office Action, the Examiner rejected claims 1, 3-4, 7, 11-12, 14, 21-22 and 24-25 under 35 U.S.C. §102(e), alleging that Henry et al. (US 6,162,818) teach several 2-

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imidazolinylaminoindole compounds useful as α_2 -adrenoreceptor agonists for treating various disorders of the α_2 -adrenoreceptors, which include the compounds claimed in the instant claims. The Examiner focused on formula I in column 3 and noted the definitions of R1, R2, R3, R4, R5, R6 and R7. The Examiner also noted that R1 is mislabeled as R8 but that both the abstract and the tables that disclose the compounds clearly show R1. The Examiner further pointed out that only one of R4, R5 and R6 can be a 2-imidazolinylamino group. The Examiner directed applicant's attention to column 7-12 and column 12-22, and noted especially examples 193-250, 251-310, and 377-438 on column 25 through 29, as including compounds purportedly claimed in the pending claims for the same use.

Claim Rejection: 35 U.S.C. §103 - Henry, et al.

The Examiner further rejected that claims 1, 3-4, 7, 10-12, 14, 21-22 and 24-25 and 28 under 35 U.S.C. §103 as being unpatentable over Henry et al. The Examiner referred to the preceding §103(c) [should be §102] rejection and alleged that the pending claims differ from the references in that they recite substituted 2-imidazolinylaminoindole groups in addition to those compounds purportedly anticipated by the prior art, Henry, et al. The Examiner stated that, for example, pending claim 28 requires an ethyl group on the indole nitrogen which is not present in the examples of the prior art compounds.

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The Examiner further stated that Henry et al. teaches equivalency of the exemplified compounds with those claimed for the compound of formula I in the definition of R1, R2, R3, R4, R5, R6 and R7. The Examiner alleged that it would have been obvious to one having ordinary skill in the art at the time of the invention to make compounds with substituents in the nitrogen of the 5-membered hetero-ring and in the aryl ring, as permitted by the reference. The Examiner further alleged that this would result in the instant compounds that possess uses taught by the art in view of the equivalency teaching outline above.

In response, applicants respectfully traverse the rejection under 35 U.S.C. §102(e) and 35 U.S.C. §103, and maintain that the pending claims are patentable. Applicants note that Henry, et al., United States Patent No. 6,162,818, issued on December 19, 2000 from U.S. Serial No. 09/290,731, filed April 13, 1999 as a continuation of PCT International Application No. PCT/US97/20801, filed November 21, 1997, which in turn claimed priority of U.S. Provisional Application No. 60/031,777, filed November 11, 1996. Accordingly, the earliest possible effective date of Henry, et al. as a reference is November 11, 1996 (Applicants do not concede that Henry, et al. is in fact, entitled to a November 11, 1996 effective filing date but for purpose of this response applicants treat Henry, et al. as if it were entitled to a November 11, 1996 effective filing date).

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Applicants submit as **Exhibit A** hereto, a Declaration Under 37 C.F.R. § 1.131 establishing a date of invention in the United States for the subject matter of the invention as now claimed prior to November 11, 1996. In the Declaration, applicants establish that prior to November 11, 1996, they conceived of their generic invention as recited in claim 1, i.e. the genus of compounds and their utility in the United States.

Additionally, applicants established that they synthesized a specific compound encompassed within the scope of their generically claimed invention, i.e. the compound of example 10 of the application in the United States prior to November 11, 1996.

Accordingly, in view of the preceding remarks and the Declaration submitted herewith, applicants respectfully request that the Examiner reconsider and withdraw Henry, et al. as a reference and withdraw all rejections based thereon.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the enclosed fee of \$950.00 for a three-month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is

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required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


John P. White

Date

Reg. No. 28,678